

**REMARKS**

Applicants thank the Examiner for the thorough consideration given the present application. Claims 26-49 are currently pending, none of which is amended. The Examiner is respectfully requested to reconsider her rejections in view of the Remarks as set forth hereinbelow.

**Request for Reconsideration / Reasons for Entry of Reply**

First of all, the Applicants respectfully submit that independent claims 26 and 37 (and the claims depending therefrom) as previously presented are in condition for allowance, and that the references cited in the latest Office Action to reject these claims are not proper and should be withdrawn. (See arguments below.)

By way of this Reply, all pending claims remain as previously presented.

Therefore, it is respectfully requested that this Reply be entered into the Official File in view of the fact that the pending claims automatically place the application in condition for allowance.

Further, all of the subject matter now set forth in each of the pending claims has been fully considered and examined by the Examiner. The pending claims do not raise any new issues that would warrant or require the Examiner to perform an additional search of the related art.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Reply be entered for the purpose of

appeal. This Reply was not presented at an earlier date in view of the fact that the Examiner has just now presented new grounds for rejection in this Final Office Action.

**Examiner Interview**

If, during further examination of the present application, any further discussion with the Applicants' Representative would advance the prosecution of the present application, the Examiner is encouraged to contact Carl T. Thomsen, at 1-703-208-4030 (direct line) at his convenience.

**Rejections Under 35 U.S.C. §§ 102 & 103**

Claims 26-32, 35-43, 46 and 47 stand rejected under 35 U.S.C. § 102(e) as anticipated by Ferre et al. Claims 33, 34, 44, 45, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ferre et al. in view of Anthony. These rejections are respectfully traversed.

**Arguments Regarding Independent Claims 26 and 37 as Previously Presented**

Each of independent claims 26 and 37 as previously presented recites a combination of elements directed to a stereostatic device, including *inter alia*

“wherein the frame is configured to contact the subject only on a nose of the subject and is configured to be located only in front of a plane defined by eyes of the subject when the frame is mounted onto the subject.”

These features are supported at least by a non-limiting example in Figs. 1 and 4.

**Regarding Ferre et al.**

The Office Action states that Ferre et al. discloses that the frame is capable of contacting only the nose of the subject and located in front of a plane defined by the eyes of the subject when the frame is mounted onto the subject (see page 2 of the Office Action).

The Applicants respectfully disagree with the Examiner's rejection.

As can be seen in Ferre et al. column 4, lines 11-26 and FIGS. 1, 2, 3, 18, 19, 28, this document merely discloses a head set 12 integrally provide with two ear mounts 28 on left and right side members 30 (which extend across the patient's forehead, above and to the rear of the eyes, and down to the ears), and a nose bridge 32 on a center member 34 extending downwardly from a point above the eyes at a center of the forehead and passing between the patient's eyes. Thus, the head set 12 of Ferre et al. contacts the forehead, both sides of the head, the two ears, and portions of the face above and between the two eyes.

The Applicants submit that one skilled in the art at the time the present invention was made, would only compare the frame 3 of the present invention to the head set 12 of Ferre et al.

Ferre et al. discloses an integrally formed head set 12 that is configured to be supported on the head by contacting the head of the patient in many areas, in addition to contacting "only the nose and located in front of a plane defined by the eyes of the subject when the frame is mounted onto the subject," as set forth in **independent claims 26 and 37**, as previously presented.

It is unreasonable and not proper for the Examiner to select a single portion (namely, center member 34) of the head set 12, as disclosing the frame 3 of the present invention.

The Applicant submit that the Examiner's selection of center member 34 out of the many different parts of head set 12, is based on mere hind sight.

Further, the center member 34 (even if considered alone, which is not proper) fails to teach or suggest the frame 3 of the present invention. As pointed out above, center member 34 extends downwardly from a point above the eyes at a center of the forehead and passes between the patient's eyes.

Thus, center member 34 part of head set 12 of Ferre et al. is positioned such it fails to teach or suggest

"the frame is configured to contact the subject only on a nose of the subject and is configured to be located only in front of a plane defined by eyes of the subject when the frame is mounted onto the subject," as previously presented in each of **independent claims 26 and 37**.

If the Examiner continues to believe that the Ferre et al. reference discloses the subject matter set forth in each of **independent claims 26 and 37**, she is respectfully requested to provide specific evidence to support her position.

Otherwise, the rejection based on the disclosure of Ferre et al. should be withdrawn.

**Inherency Test Not Met**

As the Examiner knows well, a prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

The Ferre et al. reference fails to disclose the subject matter of **independent claims 26 and 37**.

**Regarding Anthony**

Further, Anthony fails to overcome the deficiencies of Ferre et al. In addition, to relying on a reference under 35 U.S.C. 103, the prior art must be analogous to the applicant's field of endeavor. Because Anthony is directed to a device for treatment of BPPV, rather than a frame with fiducial markers, Anthony is not an analogous art. Therefore, Ferre et al., even when combined with Anthony, fails to teach or suggest the features of amended claims 26 and 37.

The Office Action equates the center member 34 and the side members 30 of Ferre et al. to the frame and the supporting element of the claimed invention (see page 3 of the Office Action). As shown Figs. 1 and 18 of Ferre et al., the side members 30 do not form a closed loop, but rather forms an open loop. Therefore, Ferre et al. fails to teach or suggest that the supporting element is attached to the frame such that the supporting element forms a closed loop, as recited in amended claims 33 and 44. Further, Anthony fails to overcome the deficiencies of Ferre et al., and as discussed above, Anthony is not an analogous art. Hence, Ferre et al., even when combined with Anthony, fails to teach or suggest the features of amended claims 33 and 44.

**Prima facie Case of Obviousness Not Established**

As the Examiner knows well, a *prima facie* case of obviousness must be established in order for a rejection under 35 U.S.C. 103(a) to be proper.

M.P.E.P. section 2143 sets forth examples of basic requirements of a *prima facie* case of obviousness:

“The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395-97 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.”

One of the exemplary rationales that may support a conclusion of obviousness in accordance with the KSR decision is set forth in M.P.E.P. 2143 (C). This exemplary rationale relates to “use of known technique to improve similar devices (methods, or products) in the same way.”

Referring to M.P.E.P. 21433 (C), the following is stated:

“To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that the prior art contained a “base” device (method, or product) upon which the claimed invention can be seen as an “improvement;”

(2) a finding that the prior art contained a “comparable” device (method, or product that is not the same as the base device) that has been improved in the same way as the claimed invention;

(3) a finding that one of ordinary skill in the art could have applied the known “improvement” technique in the same way to the “base” device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices (methods, or products) has been made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a “base” device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art. The Supreme Court in *KSR* noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d

at 1396. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.” (*emphasis added*)

Regarding **item (1)** above, the Examiner appears to consider Ferre et al. as representing the prior art containing a “base” device upon which the claimed invention can be seen as an “improvement.”

Regarding **item (2)** above, the Examiner appears to consider Anthony as representing the prior art containing a “comparable” device that has been improved in the same way as the claimed invention.

The Applicant respectfully submits that the Examiner has failed to articulate at least **items (1) and (2)** above as is required.

The Ferre et al. head set 12 is formed so as to be self supporting.

Certainly, the Examiner cannot reasonably argue that the device of Anthony constitutes a “comparable” device that has been improved in the same way as the presently claimed invention. The mere fact that the Anthony device includes a strap 500 is irrelevant. The strap of Anthony cannot improve the Ferre et al. device, since the Ferre et al. device already has a supporting member.

In view of the above, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.



*Application No. 10/627,867*  
*Reply dated April 2, 2010*  
*Reply to Office Action of November 13, 2009*

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*Art Unit: 3734*  
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Accordingly, it is respectfully submitted that **independent claims 26 and 37** and each of the claims depending therefrom are allowable.

**Dependent Claims**

All dependent claims are in condition for allowance due to their dependency from allowable independent claims, or due to the additional novel features set forth therein.

All pending claims are now in condition for allowance.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) and 103(a) are respectfully requested.

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**CONCLUSION**

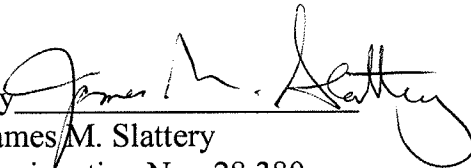
In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Carl T. Thomsen, Reg. No. 50786 at (703) 208-4030 (direct line) in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-1448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly extension of time fees.

Dated: **April 2, 2010**

Respectfully submitted,

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